

REMARKS/ARGUMENTS

In the restriction/election of species requirement dated July 30, 2008, the Examiner delineated the following inventions as being patentably distinct.

- Group I: Claim(s) 1-5, drawn to a method of using an adhesion promoter;
- Group II: Claim(s) 6-7, drawn to a multilayer film;
- Group III: Claim(s) 8, drawn to a process of making a multilayer film;
- Group IV: Claim(s) 9-12 drawn to a composite part; and
- Group V: Claim(s) 13, drawn to a process for producing a composite part.

The Examiner further required the election of species from the following:

For species (a)

Formula (I)

Formula (II)

Formula (III)

Formula (IV) or

Formula (V)

For species (b)

Formula (VI)

Formula (VII) or

Formula (VIII)

Accordingly, Applicants elect with traverse Group II (Claims 6 and 7) and for species formula (I) for (a) and for (b) formula (VI).

The Claims of Groups I-V are integrally linked as compounds, process for making and method of use.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct and there would be a serious burden placed on the Examiner if

restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusion in regard to patentable distinction. There is a technical relationship that links all of the Groups (I-V), and it is this technical relationship that defines the contribution which each of the Groups, taken as a whole makes over the prior art.

The Examiner asserts that Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 and 13.2 because they lack the same corresponding technical feature. The Examiner has not considered that the claims in each group are considered to have related inventions under 37 C.F.R. 1.475(b) in which the inventions are considered to have unity of invention.

Applicants submit that while Rule 13.1 and 13.2 are applicable, 37 C.F.R. 1.475(b) provides in relevant part that a “national stage application containing claims to different categories of invention are considered to have unity of invention if the claims are drawn to ... (3) a product, process, specially adapted for the manufacture of said product, and the use of said product....”

Moreover, Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. As the Office has not shown any evidence that a restriction should now be required when the International Preliminary Examination Report did not, restriction is now believed to be improper. Unity of invention has to be considered in the first place only in relation to the independent claim. A dependant claim is one which contains all the feature of another claim, and in the same category as other claims. It does not matter if a dependent claim itself contains a further invention.

Further, the M.P.E.P. § 803 states as follows:

If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits even though it includes claims to distinct and independent inventions.

For the reasons recited above, Applicants request that the restriction requirement be withdrawn.

Divisional applications filed thereafter claiming the non-elected species should not be subject to double-patenting ground of rejection, 35 U.S.C. 121 In re Joyce (Comr. Pats 1957) 115 USPQ 412.

Applicants further request that should the elected species be found allowable, the Examiner expand the search to include non-elected species.


Applicants submit that the above identified application is now in condition for examination on the merits and an early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 06/04)


Paul J. Killos
Registration No. 58,014

NFO:PJK\